



Paper No. 6

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OFFICE OF PETITIONS

In re Application of
Kimber, Grimshaw, Clarke, Benson, and Lester
Application No. 10/032,416
Filed: December 21, 2001
Attorney Docket No. Q64581
For: ISOLATION OF MICROWAVE TRANSMISSION LINES :

:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed August 9, 2002.

The petition under 37 CFR 1.47(a) is **dismissed**.

Any request for reconsideration under this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)."

The above-identified application was filed on December 21, 2001, without a proper oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" was mailed on February 22, 2002, requiring an executed oath or declaration and a surcharge for the late filing of the oath or declaration.

On August 9, 2002, petitioner filed the instant petition and obtained a four (4) month extension of time to file a reply. In support of the petition, petitioner filed a declaration executed by all named inventors, except inventors Grimshaw and Benson and filed copies of correspondence previously sent to inventors Grimshaw and Benson.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee,
- (4) a statement of the last known address of the non-signing inventor,

The instant petition lacks items (1) and (4) as set forth above.

As to item (1), petitioner did not sufficiently establish that a complete copy of the application papers was presented to the non-signing inventors. The correspondence filed in support of the petition only indicates that the non-signing inventors were sent the "Patent Application Assignment" and the "Declaration", but does not indicate that inventors Grimshaw and Benson were given a complete copy of the application papers (specification, including claims, drawings, and oath or declaration.) The conclusion cannot be reached that inventors Grimshaw and Benson have refused to join the application as it is not evident that

inventors Grimshaw and Benson have had the opportunity to review the entire application papers.

Section 409.03(d) of the Manual of Patent Examination provides guidance on the subject and reads, in pertinent part, as follows:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney.

Petitioner must provide some proof that the complete application papers were forwarded to the non-signing inventors whether such proof is a copy of a cover letter that may accompany the application papers when mailed to the non-signing inventors and/or a statement attesting that the complete application papers were mailed to the last known addresses for the non-signing inventors. Such evidence and/or statement should accompany any renewed petition filed under 37 CFR 1.47(a).

As to item (4), petitioner must file a statement indicating the last known address of the non-signing inventors as notices will be sent by the Office to the addresses provided advising the non-signing inventors of the approval of the 37 CFR 1.47(a) petition.

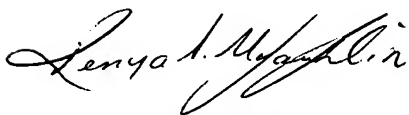
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6919
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, Virginia

Telephone inquiries should be directed to the undersigned (703) 305-0010.



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Office of the Deputy Commissioner
for Patent Examination Policy